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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/531,382   | 04/15/2005  | Takehiko Sawabe      | 2007_0588           | 6520             |
| 513 7590 01/02/2009<br>WENDEROTH, LIND & PONACK, L.L.P.<br>2033 K STREET N. W.<br>SUITE 800<br>WASHINGTON, DC 20006-1021 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| ZUCKER, PAUL A   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1621   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 01/02/2009   |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/531,382

**Applicant(s)**

SAWABE ET AL.

**Examiner**

Paul A. Zucker

**Art Unit**

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/19/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4 and 9-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5 is/are rejected.
- 7) ☐ Claim(s) 6 and 7 is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Current Status***

1. This action is responsive to Applicants' amendment of 19 September 2008.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-23 are pending.
4. Claims 3, 4 and 9-23 are held withdrawn from consideration as being drawn to a nonelected invention.
5. The rejection under 35 USC § 112, second paragraph, set forth in paragraph 3 of the previous Office Action mailed 21 April 2008 is withdrawn in view of Applicants' amendment.
6. The rejections under 35 USC § 102 set forth in paragraphs 4 and 5 of the previous Office Action mailed 21 April 2008 is withdrawn in view of Applicants' amendment.
7. The objection to the claims set forth in paragraph 6 of the previous Office Action mailed 21 April 2008 is withdrawn in view of Applicants' amendment.

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### ***New Rejections***

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8. Claims 1, 2 and 5 are finally rejected under 35 U.S.C. 102(b) as being anticipated by TOSOH (JP 08-325526 12-1996, Machine translation). TOSOH discloses (Machine translation, paragraph [0015]) the compounds 2-acryloyloxyethylmalonic acid and 2-methacryloyloxyethylmalonic acid which correspond to the compounds of 2(d) as C2-C6alkenylcarbonyloxy C1-C6 alkyl substituted compounds.

### ***Examiner's Response to Applicants' Remarks with Regard to This Rejection***

9. Applicants have argued that :

"As is evident from the attached sheets, the acryloyloxy group in these compounds refers to an "alkenylcarbonyloxy" group. An "alkenylcarbonyloxy" group is clearly distinguishable from the presently claimed "alkenyloxycarbonyloxy" recited in claim 1, group (j).

In response the Examiner points out that Applicants' have, in fact, claimed such an "alkenylcarbonyloxy" group as set forth in Claim 1(d). The clerical error resulting in the previous citation of "j" has been corrected in the rejection above.

Applicant's arguments filed 19 September 2008 have been fully considered but they are not persuasive for the reasons set forth above.

***Claim Objections***

10. Claims 6 and 7 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

11. Claims 1-23 are pending. Claims 1, 2 and 5 are finally rejected. Claims 6 and 7 are finally objected to. Claims 3, 4 and 9-23 are held withdrawn from consideration as being drawn to a nonelected invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A. Zucker whose telephone number is 571-272-0650. The examiner can normally be reached on Monday-Friday 5:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Sullivan can be reached on 571-272-0779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul A. Zucker/  
Primary Examiner, Art Unit 1621